

REMARKS

Applicant respectfully requests reconsideration of the rejections set forth in the Office Action mailed on March 1, 2007.

Claims 42 and 54 are canceled by this amendment and claims 21, 26, 34, 39, 51, 59, and 60-62 are amended. The amendments to claim 21, 61, and 62 find support, for example, at paragraphs 0061 to 0064. The amendments to claims 26, 34, 39, 51, 59, and 60 find support, for example, at paragraphs 00113 to 11114. No new matter is introduced by the amendments.

Claims 26, 34, 39-42, 51-60, and 63-75 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully does not agree with the Office's position. However, in order to expedite prosecution Applicant has followed the Examiner's suggestion at page 2 of the Office Action and amended independent claims 26, 34, 39, 51, 59, and 60 to recite "wherein at least one determined characteristic of the cells is outputted to at least one of a display and a memory device." Applicant thanks the Examiner for the suggestion and submits that the amended claims, and the remaining rejected claims that depend from the amended claims, are directed to statutory subject matter. Accordingly, this rejection should be withdrawn.

Claims 21, 42, 54, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Gerlyng in view of Bacus. Applicant has cancelled claims 42 and 54 without prejudice or disclaimer, and amended claims 21, 61, and 62 herein. Applicant respectfully traverses the rejection as to claims 21, 61, and 62.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must establish three elements. First, the Examiner must point to a

suggestion or motivation, either in the prior art or in the general body of knowledge, to modify or combine the prior art. Second, there must be a reasonable expectation of success in making the suggested modification. Third, the prior art as modified or combined must teach or suggest all limitations of the claimed invention. See M.P.E.P. 2142.

Gerlyng discloses a method of staining cells and then manually observing them under a microscope to identify binuclear cells. The Examiner has pointed to disclosures in Gerlyng of features of cells that are scored manually by a person sitting at a microscope in order to identify the proportion of binuclear cells present in a population of cells. The Examiner acknowledges that the process of Gerlyng is not automated.

Bacus describes staining cells and then analyzing them with an apparatus that allows automated scoring of the results. For example, cells can be stained with an antibody and then scored using the apparatus to identify the number of positive cells. The Examiner appears to rely on Bacus merely as teaching that automation of a process of analyzing cells has certain advantages.

Neither Gerlyng or Bacus, alone or in combination, provides a method of “automatically classifying [a] treatment based on the distribution of [a] nuclear morphology property, distribution of [an] inter-nuclear property, and abundance of bi-nuclear cells in [a] population,” as recited in the pending claims, “wherein the automatic classifying comprises comparing the distribution of the nuclear morphology property, distribution of the inter-nuclear property, and abundance of bi-nuclear cells in the population to a database of similar data derived from control untreated cells or cells subjected to a plurality of treatments.” Applicant’s claimed method is not merely an

automation of a method of scoring a feature of stained cells. Rather, Applicant's method provides an automated process of classifying a treatment by comparing multiple recited aspects of the affect of the treatment on a population of cells to a database of results of other treatments. The cited art does not disclose or fairly suggest such a method and does not render the claims obvious. Accordingly, this rejection should be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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